

REMARKS

This application has been carefully reviewed in light of the Office Action dated September 29, 2003. Claims 1-10 remain pending in this application. Claim 1 is the independent claim. Favorable reconsideration is respectfully requested.

On the merits, the Office Action rejected Claims 1-2, 7, and 10 under 35 USC § 103(a) as being unpatentable over Snell (U.S. Patent No. 6,152,435; hereinafter "Snell"). The Office Action also rejected Claims 1, 2, 4, and 7-9 under 35 U.S.C. § 103(a) as being anticipated by Engibarov (U.S. Patent No. 5,060,920; hereafter "Engibarov"). The Office Action also rejected Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Engibarov in view of McConkey (U.S. Patent No. 5,074,536; hereafter "McConkey"). The Office Action also rejected Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Engibarov in view of Gaither (U.S. Patent No. 3,626,600; hereinafter "Gaither"). The Office Action also rejected Claim 9 35 U.S.C. § 103(a) as being unpatentable over Engibarov in view of Takisawa et al. (U.S. 6,383,890 hereafter "Takisawa").

Applicant respectfully submits that the pending application and claims are patentable for at least the following reasons.

*No suggestion of obviousness*

Applicant's Claim 1 recites: "[A] holder for a cassette for semiconductor material substrates, comprising a base plate on which a guide member provided with at least two guides is secured, which cassette is arranged between the guides, which enable the cassette to be aligned and identically situated with respect to the base plate upon each introduction to the holder, and a first side of the guide member which is facing away from the base plate is embodied so as to taper inwards, wherein a second side of the guide member facing the base plate is also embodied so as to taper inwards, so that a portion of the guide member situated closest to the cassette is arranged at a predetermined distance from the base plate."

It is respectfully submitted that neither Snell nor Engibarov recite or suggest a holder for a cassette of semiconductor material substrates with guides that enable the cassette to be aligned and identically situated with respect to a base plate on each introduction to the holder.

*Holder that preset must*

In contrast, it is respectfully submitted that Snell teaches a multi-diameter vice clamp and collet jaw, and Engibarov teaches a quick-change jaw assembly for machining. Both references require tightening after insertion of the object to be clamped or fastened and do not perform any aligning function upon insertion, but rather upon tightening. The Office Action responds to this argument by stating that jaws can be preset to fit a workpiece and it will be

identically situated upon each introduction of the workpiece. However, the need to preset the jaws fails to recite or suggest enabling the cassette to be aligned and identically situated on each introduction to the holder. Clearly, at least on the first introduction to the holder, the collet jaw and clamp of Snell and jaw assembly of Engibarov require some form of tightening or sizing. Thus, the prior art references teach away from Applicant's claimed invention. Thus the references fail to recite or suggest every element of Claim 1, and also fail to provide suggestion to one of ordinary skill in the art at the time of the invention to provide such a holder.

The Office Action's Response to Arguments section claims that it is inherent in the design of a workpiece where if it sits on a holder it will be automatically identically situated with respect to the base plate upon each introduction of the workpiece to the holder. Applicant notes that a missing element is inherently present in a reference only if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art (as opposed to the examiner's expectation). Mere possibilities or even probabilities are not enough; necessity recognized by those of skill in the art is required.<sup>1</sup> The M.P.E.P. echoes this case law.

<sup>1</sup> The Federal Circuit has clearly set out the standard for inherency in, e.g., Continental Can Co. v.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

Further, the following is also emphasized:

In relying upon the theory or inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

It is well established that a recited element or step is inherently present in a prior art reference only if that element is necessarily present or necessarily performed in that reference, and further that its presence or performance would be recognized by one of ordinary skill in the art from what has been expressly described. Second, the Office Action must provide objective evidence or cogent technical reasoning to support a contention of inherency.<sup>2</sup>

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Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)(emphasis added):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In re Oelrich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting Hansgirk v. Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

This citation is also set out in M.P.E.P. § 2131.01(d).

<sup>2</sup> "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Nothing found in either Snell or Engibarov recites or suggests a holder for a cassette of semiconductor material substrates with guides that enable the cassette to be aligned and identically situated with respect to a base plate on each introduction to the holder. According to the Office Action's rationale, after an initial presetting, the jaws will fit the workpiece the same. However, the mere possibility that jaws can be preset is insufficient to support an inherency argument. Claim 1 is believed patentable over Snell and Enigbarov for at least these reasons.

Claims 2-10 depend from independent Claim 1 discussed above and are believed patentable for at least the same reasons. In addition, however, each is also deemed to define an additional aspect of the invention, and should be individually considered on its own merits. In addition, Applicant respectfully believes the § 103 rejections of Claims 3, 5, and 9 to be moot in light of the above remarks and request their withdrawal.

In view of the foregoing amendments and remarks, Applicant respectfully submits that the currently-pending claims are clearly patentably distinguishable over the cited and applied references. Accordingly, entry of this amendment, reconsideration of the rejections of the claims over the references cited, and allowance of this application is earnestly solicited.

Respectfully submitted,

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